

REMARKS

Applicants have carefully considered the October 23, 2007 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-9 were pending in this application.

In response to the Office Action dated October 23, 2007, claim 6 has been cancelled, claim 1 has been amended to include the subject matter of claim 6, and claims 5 and 7-9 have been amended to address the multiple dependency issue. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 5-9 were objected to under 37 C.F.R. 1.75(c) for being improper multiple dependent claims. Applicants request withdrawal of the objection in view of the foregoing amendments to claims 5 and 7-9 which address the multiple dependency issue.

Claims 1-3 were rejected under 35 U.S.C. § 102(b) as being anticipated over JP 09-273989. The Examiner asserted that JP '989 discloses an ozone generator including an ion exchange membrane 15 integrally grasped by a cathode plate 16 and anode plate 19, as shown in Fig. 2 and described at numbered paragraphs 8-9. Applicants traverse.

Claims 1-4 were rejected under 35 U.S.C. § 102(b) as being anticipated over Andrews et al. (U.S. Pat. No. 5,989,407, hereinafter "Andrews"). The Examiner asserted that Andrews discloses an ozone generator 12 including a cation exchange membrane 22 in intimate contact with a cathode 24 and anode 26, as shown in Fig. 1 and described at col. 10, lines 53-56. Applicants traverse.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F.3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Claim 1 has been amended to describe an ozone production device having at least a part of the electrolytic portion that is immersed in electrolysis target liquid in a storage tank in which the electrolysis target liquid is stored, and that the electrolytic portion is movable in the electrolysis target liquid, as required in amended claim 1. It is not apparent, and the Examiner has not specifically identified where either JP '989 or Andrews discloses an ozone production device having at least a part of the electrolytic portion that is immersed in electrolysis target liquid in a storage tank in which the electrolysis target liquid is stored, and that the electrolytic portion is movable in the electrolysis target liquid.

The above argued difference between the claimed ozone production device and the disclosures of JP '989 or Andrews undermines the factual determination that either reference discloses the ozone production device identically corresponding to that

claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejections under 35 U.S.C. § 102 for lack of novelty as evidenced by JP '989 or Andrews are not factually viable and, hence, solicit withdrawal thereof.

Dependent claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 09-038655 in view of Andrews. Applicants traverse.

It is not apparent, and the Examiner has not specifically identified where either JP 09-038655 or Andrews discloses an ozone production device having at least a part of the electrolytic portion that is immersed in electrolysis target liquid in a storage tank in which the electrolysis target liquid is stored, and that the electrolytic portion is movable in the electrolysis target liquid. Thus, even if the applied references are combined as suggested by the Examiner the claimed subject matter of dependent claim 4 would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, reconsideration and withdrawal of the rejection are solicited.

It is believed that all pending claims are now in condition for allowance. Applicants therefore respectfully request an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicants' representative at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Bernard P. Codd (Reg. No. 46,429)
for
Brian K. Seidleck
Registration No. 51,321

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 BKS:idw
Facsimile: 202.756.8087
Date: January 23, 2008

**Please recognize our Customer No. 20277
as our correspondence address.**